

REMARKS

Applicants submit that by the present Amendment and Remarks, this Application is placed in clear condition for immediate allowance. Certainly, the present Amendment does not raise any new issues or introduce any new matter, as discussed with Examiner Garrett on June 28, 2006. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are solicited pursuant to the provisions of 37 C.F.R. § 1.116.

Telephonic Interview of June 28, 2006.

Applicants express appreciation for Examiner Garrett's courtesy in conducting a telephonic interview on June 28, 2006. During that telephonic interview, the present Amendment was suggested to Examiner Garrett. Examiner Garrett reacted favorably and advised that such claim amendments would resolve the issue generated by the rejection of record. However, Examiner Garrett reserved final judgment pending discussions with her supervisor. Examiner Garrett did confirm that the present Amendment would be entered under 37 C.F.R. § 1.116. It is with this understanding that Applicants proceeded.

Claims 1 through 9 and 12 through 15 stand rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Toguchi et al.

In the statement of the rejection the Examiner asserted that the lower limit for the range of impurities remains zero. This rejection is traversed.

As discussed during the telephonic interview of June 28, 2006, each of the independent claims has been amended to clarify that the organic layer does contain a finite amount of the recited elements "as impurities". Of course, the maximum limit on the impurities is recited. By

definition, impurities are undesirable, otherwise they would be purposely added ingredients.

Nevertheless, one having ordinary skill in the art would have understood from the context of the present invention that although no lower limit on impurities is mentioned, the recited elements **are present** as impurities. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*).

Applicants stress that one having ordinary skill in the art would have understood that the claimed invention **requires** the organic compound layer to contain the recited metallic atom impurities, which are present in a finite amount **but limited** to the maximum recited. Toguchi et al. are silent with respect to impurities. Silence in a reference is no substitute for the requisite factual basis to support the imposed rejection. *In re Burt*, 356 F.2d 115, 148 USPQ 548 (CCPA 1966).

THE SIGNIFICANT OF THE PARTICULAR IMPURITIES

The silence in Toguchi et al. with respect to impurities is particularly fatal in the present case, because the maximum imposed limitation on the particular impurities in the claimed inventions is functionally significant. As disclosed in the paragraph bridging pages 3 and 4 of the written description of the specification, after experimentation it was discovered that **particular** metal impurities in the organic compound layer caused significant deterioration in carrier transport capability, leading to **deteriorated luminescent characteristics**. The claimed invention addresses and solves that **problem** by **controlling** the maximum amount of these **particular impurities** in the organic compound layer. That **concept** is alien to Toguchi et al.

The above argued differences between the claimed devices and the device of Toguchi et al. undermine the factual determination that Toguchi et al. disclose a device identically


Application No.: 10/813,624

corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 9 and 12 through 15 under 35 U.S.C. § 102 for lack of novelty as evidenced by Toguchi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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